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www.uspto.gov

RICHARD ARON OSMAN
SCIENCE AND TECHNOLOGY LAW GROUP
242 AVE VISTA DEL OCEANO
SAN CLEMENITE CA 92672

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JUL 27 2006

OFFICE OF PETITIONS

In re Application of	:
Lustig et al.	:
Application No. 09/163,713	: Decision on Petition for
Filed: September 30, 1998	: Patent Term Extension
Attorney Docket No. T97-012-1	:
For: NUCLEAR HORMONE RECEPTOR	:
DRUG SCREENS	:

The above-identified application has been forwarded to the undersigned for consideration on the "Petition to the Under 37 CFR 1.181," which was received on June 30, 2006, for the above-identified application. Petitioner argues that the application is entitled to more patent term extension, as the Notice of Allowance and Fees Due does not appear to take into consideration the entirety of the delay. Further requests or a request for reconsideration of this decision for patent term extension, must be filed under 37 CFR 1.182 or 37 CFR 1.183, and include the required fee, as 37 CFR 1.701 does not provide for an extension in this situation.

The petition is dismissed.

The patent term extension information has been corrected to indicate that the application is eligible for zero (0) days of patent term extension under 35 U.S.C. 154(b).

Petitioner notes that the above-identified application was filed on September 30, 1998, allowed on June 27, 2006, but was delayed due to suspensions in prosecution for a potential interference. Petitioner states that the application was suspended for almost four years through no fault of applicants until June 27, 2006. Petitioner asserts that the patent term adjustment does not appear to take into consideration the entirety of the delay. Petitioner argues that patent term extension of 281 days indicated on the Notice of Allowance and Fees Due mailed June 27, 2006 is inadequate.

35 U.S.C. § 154(b)(as amended by the "Uruguay Round Agreements Act," enacted December 8, 1994, as part of Public Law 103-465) provides for patent term extension for appellate review, interference and secrecy order delays in applications filed on or after June 8, 1995 and before May 29, 2000.

35 U.S.C. § 154(b)(as amended by the "American Inventors Protection Act of 1999," enacted November 29, 1999, as part of Public Law 106-113) provides for patent term adjustment for these administrative delays and others in applications filed on or after May 29, 2000. The patent statute only permits extension of patent term based on very specific criteria. The Office has no authority to grant any extension or adjustment of the term due to administrative delays except as authorized by 35 U.S.C. § 154.

The above-identified application was filed on September 30, 1998. Accordingly it is entitled to patent term extension based upon the conditions in 35 U.S.C. § 154(b), in effect on June 8, 1995. The provisions of 35 U.S.C. § 154(b) in effect on May 29, 2000 do not apply, because the amended version of 35 U.S.C. § 154(b) only applies to applications filed on or after May 29, 2000. Pursuant to 35 U.S.C. § 154(b), in effect on June 8, 1995, an applicant can receive patent term extension only if there was an appellate review, interference or a secrecy order delays as set forth in the statute. While petitioner argues that patent term extension should be awarded to the above identified application, both 35 U.S.C. 154(b) and 37 CFR 1.701(c)(1) require an interference proceeding under 35 U.S.C. 135(a) to be eligible for patent term extension.

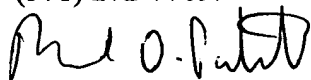
While prosecution in the application was suspended, the suspensions were due to a potential interference with applicant's application and another patent or application, not to await the result of an interference in another application. As a result, the provisions of 37 CFR 1.701(c)(1)(i) and (c)(1)(ii) do not apply. The provisions of 37 CFR 1.701(c)(1) apply to suspensions by the Patent and Trademark Office due to interference proceedings under 35 U.S.C. 135(a) and in this instance there were no interference proceedings. Both the statute and the rule require there to be "a proceeding under section 135(a)."

The Office has no authority to grant an extension of the term due to administrative delays except as authorized by 35 U.S.C. § 154. The delay in issuance of petitioner's application is regretted.

The Notice of Allowance and Issue Fee Due mailed June 27, 2006, incorrectly indicates that the patent to issue from the above-identified application is eligible for a 281-day extension when no extension is due. The Patent Application Location and Monitoring (PALM) system indicates that the application is entitled to a 281-day extension because the code for a suspension due to an interference in another application was improperly entered into the PALM system. The letter of suspension mailed by the Office on October 20, 2003, and additional suspension letters mailed by the Office all indicate that the suspensions were for a potential interference. The Office records have been corrected to indicate that the application is eligible for a 0-day extension.

After mailing of this decision, the above-identified application will be forwarded to Office of Publications for further processing. The patent, if issued, will include an indication that the patent term is extended by zero **(0) days**.

Telephone inquiries with regard to this communication should be directed to Mark O. Polutta at (571) 272-7709.



Mark O. Polutta
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy